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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,349	08/16/2001	Byung Ju Dan	2080-3-33	2633

35884 7590 05/01/2007
LEE, HONG, DEGERMAN, KANG & SCHMADEKA
801 S. FIGUEROA STREET
12TH FLOOR
LOS ANGELES, CA 90017

EXAMINER

BEKERMANN, MICHAEL

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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05/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	09/931,349		DAN ET AL.	
	Examiner		Art Unit	
	Michael Bekerman		3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/10/2007 has been entered.

Claim Objections

2. **The amendment filed 6/26/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure.** 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claim 42 recites limitations referring to a toy having a body with body parts, and further limitations referring to those body parts growing in dimension. This claim also refers to generating expressions. None of this information was disclosed in the original filing. Applicant is required to cancel the new matter in the reply to this Office Action.

3. **Claims 35 and 38-42 are objected to because of the following informalities:** Independent claims 35 and 42 appear to be apparatus claims. Apparatus claims refer

to an apparatus and the structure comprising that apparatus. The only wherein clause that appears to effectively limits these apparatus claims is the one that limits the structure claimed (the one that starts with "wherein the data interface is configured to". This limits the structure of the data interface). All of the other wherein clauses appear to recite steps to be performed ("wherein the goods or services information is downloaded in response to a user..." is an example of a step that would be found in a method claim). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 38 and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. While it is easy to see how a virtual character could grow, it is unclear as to how the toy can physically grow and this lacks an enabling explanation. It appears that applicant is attempting to claim physical growth, and while the specification recites the term "physically" when referring to growth, the specification does not have any description of how this growth could occur. In fact, the specification recites the toy as being intellectually grown (storing more information) as well. Thus, Examiner

interprets the word “physically” to refer to visual growth of a virtual character as opposed to the intellectual growth, which is not visual. Since a virtual pet could “physically” grow, as in the virtual body of the pet “physically” growing in size on the display screen, and in light of the lack of enablement, Examiner interprets the toy growing in size (as recited in claim 38) to refer to the visual growth of the virtual character, and not to the growing of the outer casing of the toy.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 35, 39, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claims 35 and 42, these claims recite the limitations “associated with desires of a living organism” and “associated with an animal's natural desires”. This is indefinite and unclear. What does a living organism desire? Not all living organisms desire the same thing. For example, many sea creatures desire to remain underwater, never coming up for air. The Examiner, however, as a living organism, does not desire this. Under the broad meaning of “desires of a living organism”, is the desire to remain underwater indefinitely to be included or excluded by the claim language? If applicant replaces the “living organism” language with a Markush listing examples supported by the specification, this would appear to overcome this rejection.

Further, since the toy does not actually “output” a desire, using language detailing the simulation of such desires can only make the claim more clear.

Referring to claims 35 and 42, these claims recite the limitation “information that satisfy the first desire”. It is unclear as to what information this refers. One person may require one sandwich to satisfy a desire for hunger while another person may desire a sandwich and a bag of chips. Satisfaction of a desire is obtained differently for each living organism. As in the previous example, if the desire is to remain underwater indefinitely, does a fish tank (or an advertisement for one) satisfy this desire? Does a swimming pool? Is the water alone enough to satisfy the desire? Would products or services meant to acquire a goldfish's satisfaction be enough to satisfy a whale? Perhaps adding language states the goods or services information is programmed to satisfy the desire would better clarify the claim.

Referring to claim 39, this claim recites the limitation “associated with emotions of a living organism”. This is indefinite and unclear. What emotions does a living organism have? Does a single-celled organism have emotions? If this question can't even be answered, then the indefinite nature of the claim is made even worse.

Referring to claim 42, this claim recites the limitation “at least one of the body parts grows in dimension”. It is unclear how this type of limitation can be implemented in the real world while referring to something that is a non-living object. While looking at the specification, no indication was even hinted at for how this could be done.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language:

6. **Claims 35, and 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Dureau (U.S. Patent No. 6,513, 160).** Dureau teaches a toy requiring a user to view advertisement information to maintain the health of a virtual character that includes all of the limitations recited in the above claims.

Regarding claims 35, and 38-40, Dureau teaches outputting “desires of a living organism” (the health of the genie reads on this and emotions) (Column 6, Lines 33-36), processing information inputted by way of a data interface (inherent with a cable television connection), downloading user-selected advertising information that “satisfies” a desire (Column 2, Lines 56-59 and Column 3, Line 57), and discontinuing the outputting of the first desire (the genie remains or becomes healthy) (Column 6, Lines 33-36 and 60-62). As explained in the 112 rejections, the genie growing in size reads on the limitation reciting “the toy grows in size”.

Claims 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Ng (U.S. Patent No. 5,971,855). Ng teaches a toy requiring a user to log onto a website to

restore a virtual character's health that includes all of the limitations recited in the above claims.

Regarding claims 35-40, Ng teaches a virtual character that outputs "desires of a living organism" (Column 5, Lines 53-55), connects to a website to download goods or services information (Column 6, Lines 37-39, and Column 4, Lines 1-4) offered by one or more advertising entities (the website is considered to be an advertising entity), discontinues outputting information dealing with the first desire and grows in size (Column 4, Lines 1-4). As explained in the 112 rejections, the genie growing in size reads on the limitation reciting "the toy grows in size".

Claims 35 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Rupport (U.S. Patent No. 5,424,524). Rupport teaches a device displaying products to be acquired through scanning means that includes all of the limitations recited in the above claims.

Regarding claims 35 and 41, Rupport teaches a device that outputs information associated with desires of a living organism (the living organism in this example desires the shopping list items yet to be obtained, which the device outputs to the display), downloads goods or services information offered by advertising entities, scans products to satisfy the desire, and discontinues the outputting of the desire once scanned (once the item is scanned, the item is checked off so the desire for the item is no longer displayed). All of this is taught by the Abstract and Figure 1 of Rupport.

Claims 35-37, 39, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Bloomfield (U.S. Pub No. 2002/0028704). Bloomfield teaches a toy requiring a user to visit a website to restore a virtual character's health that includes all of the limitations recited in the above claims. (Until applicant perfects the priority to the foreign documents claimed, Bloomfield's 02/28/2001 date is still valid

Regarding claims 35-37, 39, and 40, Ng teaches a virtual character that outputs "desires of a living organism", connects to a website to download goods or services information offered by one or more advertising entities, and discontinues outputting information dealing with the first desire (Paragraphs 0105 and 0109).

Allowable Subject Matter

7. Claim 42 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph and objections concerning new matter, set forth in this Office action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MB



JEFFREY D. CARLSON
PRIMARY EXAMINER